

**REMARKS/ARGUMENTS**

1. Claims 1 – 17 have been rejected under 35 USC 112, second paragraph as being indefinite.

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With respect to Claims 1 – 4, the Office Action again has mistakenly categorized these claims as reading upon an apparatus. This, in fact, is not so. Claims 1 – 4 are drawn to a method of doing business wherein a vehicle disablement system is installed during a government required inspection. Such methods of doing business are now statutory subject matter. Applicant respectfully requests that the new formation of these claims be reevaluated and that the rejection of Claims 1 – 4 under 35 USC 112, second paragraph be withdrawn. Applicant believes that these claims, at the request of the Examiner, may be divided so as to allow the remaining claims to be allowed.

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With respect to Claims 5, 11, and 17, Applicant has amended these claims to further clarify the claimed method and apparatus. Such amendment is in accord with the suggestions proffered by the Examiner, for which the Applicant is grateful. Applicant believes that the newly amended claims are definite.

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2. Claims 1 has been rejected under 35 USC 102(b) as being anticipated by Davis (US Pat. No. 4,854,144). Applicant has cancelled, without prejudice, Claims 2 and 3 and has incorporated the limitations of Claims 2 and 3 into Claim 1. Applicant believes that such further clarification of Claim 1 now distinguishes Claim 1 from the art of record.

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3. Claims 1 and 2 have been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US Patent No. 5,918,256 to Delaney et al.

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Applicant notes that the burden of establishing obviousness rests on the Examiner. In order to support a prima facie case for obviousness using a particular set of references, the references must exhibit the following attributes:

- (a) The prior art references *must* collectively *teach* or suggest *all* of the *claim limitations* in the application;
- (b) There must be a reasonable expectation of success in modifying the reference; and
- (c) The references must suggest or provide some motivation to modify and / or combine the reference teachings.

Here, the claimed invention of Claim 1 (Claim 2 now being cancelled) is a method for installing a system for disabling the vehicle during a government required inspection. Delaney does describe a vehicle emission analysis system. Although Muise does describe a system for disabling a vehicle and Delaney does describe a system for analyzing emissions, the fact remains that neither reference teaches the installation of a system during performance of a government required inspection. The Office Action admits that Muise is silent on the matter of installing the system disclosed therein during a government required inspection. The Office Action avers that one statement in Muise that installation of a vehicle disablement system can be accomplished by "alternative installation method for older vehicles" still does not even remotely suggest that such installation be conducted during a government required inspection. As such, the prima facie case must fail since this feature of the claimed method is not described nor even remotely suggested in either reference.

A prima facie case of obviousness further requires that there be found some motivation to modify and/or combine the reference teachings. This motivation

can come from the references themselves. Here, no such motivation is found in either reference. Applicant can not find any such motivation in Delaney. As an alternative to finding motivation in the references themselves, the Office Action must put forth a convincing line of reasoning as to why the artisan would have been motivated by the reference teachings to make the modification or combine the reference teachings. Further, the Office Action has not provided any rationale that would support this alternative motivation requirement. The Office Action has merely stated that “it would have been obvious” to install the system during the inspection process. because this would minimize drivers off-road time and provide for installation by a licensed technician” This statement, is hardly a convincing line of reason as to why an artisan would have been motivated to combine the reference teachings.

First, Delaney is drawn to a system for analyzing vehicle emissions. Why would an artisan interested in installing a disablement system ever look to a teachings on the analysis of vehicle emissions? This is why the rule against the use of non-analogous art exists. There is simply no nexus between the two fields of endeavor.

Second, why would the notion of retrofitting or have anything to do with minimizing a drivers off-road time. The amount of time devoted to emission control, a process that requires the vehicle to be in operation, can not be concurrent to the installation of a disablement system where the computer is reprogrammed thereby making the vehicle inoperable during the installation time – so, there is no timing savings to the driver. Further, the notion of using a licensed technician is simply not germane. For example, the government requiring the inspection may actually require additional licensure for personnel installing a disablement device. Again, the reasoning proffered in the Office Action is simply unpersuasive.

Accordingly, the Office Action has failed to establish a prima facie case of obviousness. Accordingly, Applicant requests that the rejection of Claims 1 and 2 under 35 USC 103 be withdrawn.

5 Applicant also notes that, in order to be used to sustain a rejection of a claim under 35 USC 103, a reference must be from an analogous art. Here, Musie and Delany are from entirely different fields of endeavor. The two references can not be combined in order to sustain the rejection of Claims 1 and 2 under 35 USC 103. In the currently operative office action, the Examiner avers that  
10 Musie is from analogous art simply because they are both concerned with the automotive industry. Applicant notes that the automotive industry encompasses a great many desperate fields of endeavor. Performing emission testing (Delaney), for example, is concerned with promoting lower vehicle emissions. This is far removed from disabling a vehicle.

15 With respect to requiring installation of a disablement system during a border crossing inspection, the office action again provides no teaching on this limitation of newly amended Claim 1 – neither reference teaches installation during a boarder crossing inspection. The Examiner also failed to provide a  
20 convincing line of reasoning as to why Hutmacher would be useful in making this conclusion. All Hutmacher says, as admitted by the office action, is to suggest that a disablement system would be needed because vehicles run roadblocks, toll booths and inspection points. Applicant notes that this teaching only establishes that a disablement system is needed, not that it  
25 should be installed at an inspection point. In fact, once a vehicle runs a roadblock, a toll booth or an inspection point it is a little late to install the disablement system.

4. Claim 3 has been rejected under 35 USC 103(a) as being unpatentable over US Patent No. 6,072,248 to Muise et al., in view of US Patent No. 5,918,256 to Delaney et al., in further view of US Patent No. 6,371,000 to Hutmacher et al.

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Applicant notes that Claim 3 is dependent on Claim 1. As such, Claim 3 must be found as non-obvious in light of Applicant's demonstration that Claim 1 is non-obvious.

- 10 5. Claims 4 – 16 have not been formally rejected. As such, Applicant can only comment that Claim 5 and its dependent claims, Claim 11 and its dependent claims and Claim 16 and its dependent claims appear to be distinguished over the art or record. In the prior office action, Claim 5 was rejected as anticipated by Musie (US Pat. No. 6,072,248). Applicant believes that Musie
- 15 does not anticipate the claimed method and apparatus. In the currently operative Office Action, Claim 5 is mentioned in connection with Muise and Hutmacher (US Pat. No. 6,371,000). Although Claims 5, 11 and 16 have not been formally rejected, Applicant anticipates that the Examiner would have rejected these claims under 35 USC 103. However, rejection under 35 USC
- 20 103 would be improper because this combination of references fails to teach the disablement of an ignition control computer. The office action mentions that Hutmacher describes that a disablement system can be used to disable an electronic ignition. Applicant asks that the Examiner carefully consider the art of record with respect to this issue. For example, Hutmacher is an
- 25 invasive system that generates a disruptive pulse of energy and applies this disruptive pulse of energy from outside the vehicle. Here a disablement signal generated as a result of a radio signal (or lack thereof) is directed to the ignition control computer. Hence, there is no teaching to direct a control signal to the ignition control computer. Also, the Examiner must consider the
- 30 inventions as whole teachings – the Examiner would be piecing a rejection

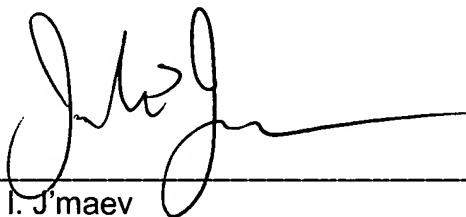
together and surely he must know that this is not allowed. Also, if the Examiner were to insist that Hutmacher could be modified to arrive at the claimed invention, the entire principal of Hutmachers invention would be thwarted rendering it unfit for its intended purposed.

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6. Based on the foregoing, Applicant considers the present invention to be distinguished from the art of record. Accordingly, Applicant respectfully solicits the Examiner's withdrawal of the rejections raised in the above referenced Office Action, such that a Notice of Allowance is forwarded to
- 10 Applicant, and the present application is therefore allowed to issue as a United States patent.

Respectfully submitted,

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